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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,105	12/12/2006	Wolfram Andersch	ANDERSCH=1	2886
1444 7590 09/09/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PACKARD, BENJAMIN J				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
09/09/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/555,105

Applicant(s)

ANDERSCH ET AL.

Examiner

Benjamin Packard

Art Unit

1612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2pgs (02/22/2010), 2pgs (6/23/2010).

DETAILED ACTION

Applicants' arguments, filed 6/22/2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-5 and 8-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over teachings of Watanabe et al (WO 01/02378, see IDS dated 03/09/07) in view of Cullen et al (US 4,748,186, see 892 dated 6/16/08), and Assmann et al (US 6,277,791, see 892 dated 6/16/08).

Applicants assert that Watanabe only provides reasoning that synergism "might possibly occur" in some mixtures, but thousands of tests would be required to determine if a synergistic effect is present. Applicants also assert the Office is using Applicants disclosure in the paragraph spanning pgs 3 and 4 of the Office action dated 12/31/09. Finally, Applicants assert widening of the spectral activity does not necessarily lead to a synergistic effect and no guidance is provided in the selection of specific pesticides.

Examiner disagrees. First, Examiner notes Applicants have narrowed the claims to the embodiments disclosed in the prior art which show super additive effect, i.e.

synergistic effect. Therefore, the relevant question is not whether such results are present, but whether they are unexpected.

In determining whether the results are unexpected or not, the Office looks to the art for teaching which might suggest the presence of synergistic effects. The specific compounds labeled instantly as formula (I) appear to be explicitly disclosed in Watanabe et al as the active agent. The active is specifically taught to be useful when combined with other known fungicides, bactericides, acaricides, nematocides, or insecticides for the purpose of widening the activity spectrum or to prevent the development of resistance, where such results are of a "synergistic effect".

In reviewing the disclosure of the combination, Examiner notes that widening the activity spectrum would not be considered an additive effect, as asserted by Applicants, but appears to suggest spectrum of activity is wider than either agent alone. This position is further support by the not that active resistance may be increased by the combination. As such, a synergistic effect may occur when combined with the various agents specifically disclosed.

Where the prior art specifically discloses synergistic effect may occur, the analysis then turns to predictability in the art and level of skill in the art. Here, the art is directed to pesticides which is a well established art technology and there are known predictable pesticidal models. The level in the art is likely a research chemist developing new pesticidal composition, who likely has an advanced education, including a Ph.D. in chemistry. With a high level of education and an established field of art, the predictability in the art need not be perfect, but may allow for some variance where the

skilled artisan, through routine testing, may quickly deduce what combinations produce the desired effect. Example 1 at pg 18 of Watanae et al discloses a specific working model for testing the agents for soil contaminated with *Meloidogyne incognita* which simply requires mixing the combination of two components and testing on the soil sample. Testing the various component combination would simply require following similar procedures for the respective pest to be treated (based on the secondary agent), i.e. mixing the components and contacting a pest model to be tested.

Examiner notes that Applicants disclosure was not relied upon for the testing the agents, as asserted by Applicants, but that such routine testing would be a matter of routine testing as illustrated by Watanabe et al as outlined above. Thus, where all that is required is the mixing of the main component with various secondary agents, and then testing the combination on the respective pest model, such testing would no be over burdensome to the skilled artisan where the technology is reasonably predictable.

Conclusion

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-R 8-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin Packard/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612